

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Thiele, Jr.

Serial No.: 10/827,564

Group Art Unit: 3652

Filed: April 19, 2004

Examiner: D. Kramer

For: SHOVELS AND OTHER IMPLEMENTS WITH SCALLOPED LEADING EDGES

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being written to address new points of arguments raised by the Examiner in the Examiner's Answer mailed January 17, 2008.

In the "Response to Arguments" section, the Examiner concedes that "[t]he notches shown in Figure 1 and 3 of the Hicks patent appear to have straight sides rather than arcuate or circular segments. Also, the Hicks notches terminate in flattened tips rather than 'distinct forward points' as called for in the claims of the instant application." (Examiner's Answer, p. 5)

The Examiner goes on to justify the additional teachings of Dawley or Vogel on the grounds that "[t]his scalloped and pointed design allows the blade to cut through the material being removed." The Examiner reaches the conclusion on the top of page 6 of the Answer that "[t]he resulting shovel would penetrate and break apart ice and compacted snow more easily than flattened tips." How does the Examiner know this? Did the Examiner conduct an experiment? If so, those results should be presented and made of record.

In making the Hicks/Dawley or Hicks/Vogel combinations, the Examiner argues "that a person of ordinary skill in the art should not be limited to Hicks himself..." That might be true *only* if the disclosure of Hicks does not teach away from the proposed combinations, *which it does*. The Examiner's attention is directed to lines 37-45 of Hicks, which read as follows:

"My invention is designed to make the penetration of the shovel-blade into the snow or ice when compacted by any means more easy, and the breaking up and removal of snow or 40 ice more readily done, by using strips or shoes constructed with serrated or broken edges so constructed as to form *a series of cutting-edges or plows*, which will readily enter into and break up compact snow and ice."

To one of skill in the art "a series of cutting-edges or plows" would more likely be interpreted as a series of notches with straight sides and flattened tips as opposed to rounded scallops. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

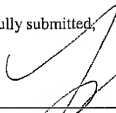
For all the Examiner knows, the straight-edged notches of Hicks might work better than Applicant's scalloped design. The Examiner reasoning is nothing more than an "obvious to try" suggestion based upon conjecture.

With regard to claims 2-5 Appellant reiterates arguments made in the Appeal Brief that "to dimension the resulting circular segments to various sizes and quantity depending on the desired task at hand" fails to address structural claim limitations deserving of examination.

As per claim 8, the Examiner now argues that "even if one defines a scoop as having a bottom and at least three surrounding walls, then the bottom of such a scoop is a *portion* of that scoop." Examiner's Answer, bottom of p. 6, top of p.7, emphasis in original. The Examiner is misinterpreting Appellant's claims. Claim 1 sets forth *an improved blade for a shovel* having "a scoop portion" – not "a portion of a scoop."

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,



By: _____

John G. Posa
Reg. No. 37424
Gifford, Krass, Sprinkle, Anderson &
Cipkowski, P.C.
PO Box 7021
Troy, MI 48007-7021
(734) 913-9300

Date: March 17, 2008